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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/409,457	09/30/1999	MARTIN C. FLAUTT	24649A	5361

7590

04/29/2002

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EXAMINER

EGWIM, KELECHI CHIDI

ART UNIT	PAPER NUMBER
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1713

19

DATE MAILED: 04/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/409,457

Applicant(s)

FLAUTT ET AL.

Examiner

Dr. Kelechi C. Egwim

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Prosecution Application

1. The request filed on 4/8/02 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/409,457 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 112

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims recite a "water-soluble superabsorbent polymer precursor". However, the definition in applicants disclosure of the "water-soluble superabsorbent polymer precursor" is not enabling for one skilled in the art to recognize which materials satisfy the requirements for a "water-soluble superabsorbent polymer precursor" in order to make and/or use the invention. Applicant's definition of the "water-soluble superabsorbent polymer precursor" is in-fact contradictory and conflicting.

For instance, in page 10, lines 3-6 of the present specification, applicant defines the "water-soluble superabsorbent polymer precursor" to be exemplified by the group of **water-soluble** (emphasis added) polyacrylates possessing the required **ability to absorb and desorb large quantities of water**". As one of skill in the art, the examiner does not understand how the "water-soluble superabsorbent polymer precursor" can be on the one hand "water-soluble" and on the other hand have the "ability to absorb and desorb large quantities of water". A "water soluble polyacrylate" would dissolve in water and not adsorb or desorb it. A superabsorbent water-swellaable polyacrylates, on the other hand, would be able to absorb and desorb large quantities of water, however such superabsorbent water-swellaable polyacrylates, which are often crosslinked (cured), CANNOT be "water-soluble".

Applicant appears to be intermingling the definition for the "superabsorbent polymer", as defined in page 1, lines 5-12 of the present specifications with the definition for the "water-soluble precursor", defined in page 9, lines 21-26 as being water-sellaable and enabled to desorb water **after it has cured into the superabsorbent coating**.

Water-swellaable (having the ability to absorb and/or desorb water) and water-soluble **are necessarily mutually exclusive**. The "water-soluble superabsorbent polymer precursor" cannot be both water-soluble and water-swellaable. Therefore, the claimed "precursor" is not enabling.

Claim Rejections - 35 USC § 102

4. Claims 1-6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Kono et al. or Kroesbergen for reasons cited in the previous Office action.

Claim Rejections - 35 USC § 103

5. Claims 9-15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Kono et al. or Kroesbergen for reasons cited in the previous Office action.

6. Claims 1-5 and 8-15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Gaa et al. or Cossement et al. for reasons cited in the previous Office action.

7. Claims 1-15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arroyo et al. or Geursen et al. in combination with Barch et al. for reasons cited in the previous Office action.

Response to Arguments

8. Applicant's arguments filed 12/9/01 have been fully considered but they are not persuasive.

9. Regarding applicant's arguments against Kroesbergen or Kono et al., it is unclear what any alleged subsequent curing of the Kroesbergen or Kono et al. polyacrylate

Art Unit: 1713

resins + binders has to do with the coating of the substrates with the blends/mixtures as claimed. The articles comprising a surface initially coated with polyacrylate polymers and binders are still taught by the prior art.

10. Also, while the references may or may not expressly disclose the polymer to be "obtained" as an aqueous solution as recited in the present claims 8-15, the claimed product coating is still the same as the presently claimed product. An otherwise old product or composition is still not patentable regardless of any new or unexpected utility or properties. See *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983) and *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985). See also MPEP § 2113. Further, each of Kono et al. or Kroesbergen teach the binder to be at least one of binders recited in the claims.

Further, applicant's definition of the claimed "water-soluble superabsorbent polymer precursor" is conflicting and therefore not enabling.

11. Again, as stated in the last Office action, applicant has still failed to point out where either Gaa et al. or Cossement et al., allegedly disclose that the water resistant coatings shed water on contact. Each still teach the articles with surfaces covered with the composition of claims 1-7 (as much as the definitions are enabled) and each teaches the product to be water resistant.

12. In response to applicant's arguments against the 103 references individually, one cannot show nonobviousness by attacking references individually where the rejections

are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

As stated in the last Office action in response to applicant's argument that there is no suggestion to combine Arroyo et al. or Geursen et al. with Barch et al, each of Arroyo et al. (col. 3, line 1-15 and col. 4, lines 11-20) and Geursen et al. (col. 1, lines 7-10 and col. 3, lines 31-41) teach superabsorbent-coatings for fibrous substrate comprising a water-soluble polymer and other optional component such a viscosity modifying polymers and Barch et al. (See col. 6, lines 18-20) teach the incorporation of binders into coating compositions for fibrous **substrate for the purpose of facilitating the formation of a film on the substrate** upon the drying of the coating composition. There in lies the motivation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (703) 306-5701. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are 305-3599 for regular communications and 305-3599 for After Final communications.

Art Unit: 1713

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

A handwritten signature in black ink, appearing to be 'KCE', with a long, sweeping horizontal line extending to the right.

KCE
April 29, 2002